UNITED STATES PATENT AND TRADEMARK OFFICE

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/080,793	02/20/2002	Clifford N. Click JR.	SUN1P231C1/P3911	2841

22434	7590	02/24/2005

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EXAMINER
PHAM, CHRYSTINE

ART UNIT	PAPER NUMBER
2122	

DATE MAILED: 02/24/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

PTO-90C (Rev. 10/03)

<table>
<tr><td rowspan="3">Office Action Summary</td><td>Application No.</td><td>Applicant(s)</td><td></td></tr>
<tr><td>10/080,793</td><td>CLICK ET AL.</td><td></td></tr>
<tr><td>Examiner</td><td>Art Unit</td><td></td></tr>
<tr><td></td><td>Chrystine Pham</td><td>2122</td><td></td></tr>
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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE <u>3</u> MONTH(S) FROM
THE MAILING DATE OF THIS COMMUNICATION.
- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed
  after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
  Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any
  earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on <u>20 February 2002</u>.

2a)☐ This action is **FINAL**.   2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is
closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) <u>1-8</u> is/are pending in the application.

    4a) Of the above claim(s) <u>6-8</u> is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) <u>1-5</u> is/are rejected.

7)☒ Claim(s) <u>3</u> is/are objected to.

8)☒ Claim(s) <u>6-8</u> are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☒ The drawing(s) filed on <u>20 February 2002</u> is/are: a)☒ accepted or b)☐ objected to by the Examiner.

    Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

    Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

    a)☐ All   b)☐ Some * c)☐ None of:

      1.☐ Certified copies of the priority documents have been received.

      2.☐ Certified copies of the priority documents have been received in Application No. _____.

      3.☐ Copies of the certified copies of the priority documents have been received in this National Stage
application from the International Bureau (PCT Rule 17.2(a)).

    * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1)☒ Notice of References Cited (PTO-892)

2)☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)

3)☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date <u>10/21/02, 12/23/02</u>.

4)☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ .

5)☐ Notice of Informal Patent Application (PTO-152)

6)☐ Other: _____ .

DETAILED ACTION

1.   This action is responsive to application 10/080793 filed on February 20th 2002. Claims 1-8 are

presented for examination.

Election/Restrictions

2.   Restriction to one of the following inventions is required under 35 U.S.C. 121:

    I.   Claims 1-5, drawn to generating an adapter/stub, classified in class 717, subclass 139.

    II.   Claims 6-8, drawn to processing a bytecode, classified in class 717, subclass 148.

        Inventions I and II are related as combination (Group II) and subcombination (Group I).

Inventions in this relationship are distinct if it can be shown that (1) the combination as claimed does not

require the particulars of the subcombination as claimed for patentability, and (2) that the subcombination

has utility by itself or in other combinations (MPEP § 806.05(c)). In the instant case, the combination as

claimed does not require the particulars of the subcombination as claimed because the particulars

involved with the step of generating an adapter is not required in the processing of bytecode. The

subcombination has separate utility such as machine state manipulation utilized in software debugging.

        During a telephone conversation with Michael Ferrazano (Registration No. 44,105) on February

17th 2005, a provisional election was made without traverse to prosecute the invention of Group I, claims

1-5. Affirmation of this election must be made by applicant in replying to this Office action. Claims 6-8

are withdrawn from further consideration by the examiner, 37 CFR 1.142(b), as being drawn to a non-

elected invention.

Claim Objections

3.   Claim 3 is objected to because of the following informalities: incorrect spelling of the word

"identifies" (line 5). Appropriate correction is required.

Claim Rejections - 35 USC § 101

4.   35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

5.   Claim 5 is rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

Claim 5

Claimed as "computer program product wherein the computer readable medium is selected from the group consisting of ... data signal embodied in a carrier wave", it does not limit the claimed "product" to **tangible** products and media because "a carrier wave" is an intangible medium incapable of being touched or perceived absent the tangible medium through which it is conveyed. Such intangible product constitutes a nonstatutory manufacture.

Claim Rejections - 35 USC § 102

6.   The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

7.   Claims 1-5 are rejected under 35 U.S.C. 102(b) as being anticipated by Sidik et al. (US 5675804), hereinafter, *Sidik et al.*.

Claim 1

Sidik et al. teach in a computer system, a method for generating an adapter/stub (e.g., see adapter code 304 FIG.3 & associated text; see 304 FIG.8 & associated text; see adapter code col.2:25-50), comprising:

- o identifying a machine state input parameter for a machine state (e.g., see compiled representation, interpretive procedure col.2:25-36);

- o identifying a call to compiled code input parameter for a call to compiled code (e.g., see compiled computer program, interpretive computer program col.1:35-65; see compiled representation, interpretive procedure col.2:25-36);

- o mapping the machine state input parameter and the machine state to the call to compiled code input parameter (e.g., see 608 FIG.6 & associated text); and

- o mapping the machine state and a return value to an exit point of an interpreter to compiled code adapter (e.g., see 612 FIG.6 & associated text).

Claim 2

The rejection of base claim 1 is incorporated. Sidik et al. further teach

- o providing a stub representation (e.g., see adapter code 304 FIG.3 & associated text; see stub col.5:45-67) to a compiler for compilation (e.g., see compilation, adapter code 304 col.5:45-67); and

- o generating object code based upon the compilation (e.g., see object code, adapter code 304 col.5:45-67).

Claim 3

Sidik et al. teach a computer program product (e.g., see computer program product col.4:53-col.5:10) that implements an apparatus for generating an adapter/stub (e.g., see adapter code 304 FIG.3 & associated text; see 304 FIG.8 & associated text; see adapter code col.2:25-50), comprising:

- o computer code that identifies a machine state input parameter for a machine state (e.g., see compiled representation, interpretive procedure col.2:25-36);

o computer code that identifies a call to compiled code input parameter for a call to compiled code

(e.g., see *compiled computer program, interpretive computer program* col.1:35-65; see *compiled representation, interpretive procedure* col.2:25-36);

o computer code that maps the machine state input parameter and the machine state to the call to

compiled code input parameter (e.g., see *608* FIG.6 & associated text); and

o computer code that maps the machine state and a return value to an exit point of an interpreter to

compiled code adapter (e.g., see *612* FIG.6 & associated text); and

o a computer readable medium (e.g., see *computer usable storage medium* col.4:53-col.5:10) that

stores the computer codes.

Claim 4

The rejection of base claim 3 is incorporated. Claim recites limitations, which have been addressed in claim 2, therefore, is rejected for the same reasons as cited in claim 2.

Claim 5

The rejection of base claim 4 is incorporated. *Sidik et al.* further teach wherein the computer readable medium is selected from the group consisting of CD-ROM, floppy disk, tape, flash memory, system memory, hard drive, and data signal embodied in a carrier wave (e.g., see *210-216* FIG.2 & associated text; see *floppy disk drive, hard disk drives* col.4:53-col.5:10).

Conclusion

8.   The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

9.   Any inquiry concerning this communication or earlier communications from the examiner should be directed to Chrystine Pham whose telephone number is 571-272-3702. The examiner can normally be reached on Mon-Fri, 8:30am-5pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's

supervisor, Tuan Q Dam can be reached on 571-272-3695. The fax phone number for the

organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent

Application Information Retrieval (PAIR) system. Status information for published applications

may be obtained from either Private PAIR or Public PAIR. Status information for unpublished

applications is available through Private PAIR only. For more information about the PAIR system,

see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR

system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

February 22, 2005
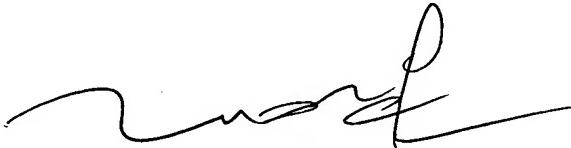
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